

**REMARKS****INTRODUCTION:**

In accordance with the foregoing, claims 1 and 13 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-18 are pending and under consideration. Claims 19 and 21 are withdrawn. Reconsideration is respectfully requested.

**ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116:**

Applicant requests entry of this Rule 116 Response and Request for Reconsideration because:

- (a) it is believed that the amendments of claims 1 and 13 put this application into condition for allowance;
- (b) the amendments were not earlier presented because the Applicant believed in good faith that the cited prior art did not disclose the present invention as previously claimed;
- (c) the amendments of claims 1 and 13 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; and/or
- (d) the amendments place the application at least into a better form for appeal.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." ( Underlining added for emphasis) Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

**EXAMINER'S RESPONSE TO APPLICANT'S RESPONSE FILED JULY 31, 2007:**

In the Office Action, at pages 2-3, the Examiner presented his arguments with respect to Applicant's response filed July 31, 2007.

In view of the amendments and arguments presented herein, it is respectfully submitted that the Examiner's concerns have been overcome.

**REJECTION UNDER 35 U.S.C. §103:**

- A. In the Office Action, at pages 3-12, numbered paragraph I, claims 1-6, 8-14, and 16-

18 (typographical error in Office Action states "16-20", but claim 19 is withdrawn and claim 20 is canceled) were rejected under 35 U.S.C. §103(a) as being unpatentable over Sekikawa (USPN 6,498,658; hereafter, Sekikawa) in view of the applicant's admitted prior art in the background of the invention (hereafter, Background). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Independent claim 1 has been amended to include the terminology: "wherein a size of image data displayed on a monitor occupies part of a full screen of the monitor and a user prints the image at the image display-free printing unit by selecting a desired image while another application of the user or another user is contemporaneously displayed on the monitor." Independent claim 13 has been amended in similar fashion. These amendments are supported by paragraph [0028] of the specification. The terminology "display-free image printing unit" has been amended to recite ---image display-free printing unit--- for clarity.

As stated in the Abstract of Sekikawa, recited below for the convenience of the Examiner, Sekikawa teaches that obtaining the objective image data out of many files in a storage device by pointing at one of the small images which are made from the stored image data and displayed on operation panel of a digital copying apparatus:

An image read part reads documents and stores the image data thereof in a memory card. Reduced image creating device creates reduced image data according to stored image data. The reduced images are displayed as an icon on display of an operation panel by using the reduced image data. One of the icons displayed on the display is selected a using pointing device, the image data corresponding to the selected icon is read from the memory card and an image is printed out.

Hence, it is respectfully submitted that neither Sekikawa nor the Background, alone or in combination, teaches or suggests a method of printing an image using a display-free image printing unit, which prints an image corresponding to image data read from an external memory card, and a personal computer, which is connectable to the display-free image printing unit,... wherein a size of image data displayed on a monitor occupies part of a full screen of the monitor and a user prints the image at the image display-free printing unit by selecting a desired image while another application of the user or another user is contemporaneously displayed on the monitor, as is recited in amended independent claim 1 and similarly in amended independent claim 13 of the present invention.

Thus, it is respectfully submitted that amended independent claims 1 and 13 are patentable under 35 U.S.C. §103(a) over Sekikawa (USPN 6,498,658) in view of the applicant's admitted prior art in the background of the invention (Background), alone or in combination. Since claims 2-12 and 14-18 depend from amended independent claims 1 and 13, respectively,

claims 2-12 and 14-18 are patentable under 35 U.S.C. §103(a) over Sekikawa (USPN 6,498,658) in view of the applicant's admitted prior art in the background of the invention (Background), alone or in combination, for at least the reasons amended independent claims 1 and 13 are patentable under 35 U.S.C. §103(a) over Sekikawa (USPN 6,498,658) in view of the applicant's admitted prior art in the background of the invention (Background), alone or in combination.

B. In the Office Action, at pages 12-13, numbered paragraph II, claim 7 was rejected under 35 U.S.C. §103(a) as being unpatentable over Sekikawa (USPN 6,498,658; hereafter, Sekikawa) in view of applicant's admitted prior art in the background of the invention (hereafter, Background) and further in view of Bubie et al. (USPN 6,453,078; hereafter, Bubie). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Independent claim 1 has been amended to include the terminology: "wherein a size of image data displayed on a monitor occupies part of a full screen of the monitor and a user prints the image at the image display-free printing unit by selecting a desired image while another application of the user or another user is contemporaneously displayed on the monitor." This amendment is supported by paragraph [0028] of the specification. The terminology "display-free image printing unit" has been amended to recite ---image display-free printing unit--- for clarity.

As recited above, neither Sekikawa nor the Background, alone or in combination, teaches or suggests a method of printing an image using a display-free image printing unit, which prints an image corresponding to image data read from an external memory card, and a personal computer, which is connectable to the display-free image printing unit,... wherein a size of image data displayed on a monitor occupies part of a full screen of the monitor and a user prints the image at the image display-free printing unit by selecting a desired image while another application of the user or another user is contemporaneously displayed on the monitor, as is recited in amended independent claim 1.

As stated in the Abstract of Bubie, recited below for the convenience of the Examiner, Bubie teaches a method which enables multiple images to be sized, positioned and printed on a hardcopy printer:

A method for selecting and arranging digital images to be printed from a group of thumbnail images is disclosed. The method comprises the steps of displaying the group of thumbnail images; selecting, from the group of thumbnail images, the number of images to be printed per page and the images which are to be printed on each page; automatically arranging the selected images for each page to be printed; and printing the arranged images. (emphasis added)

Hence, it is respectfully submitted that neither Sekikawa, the Background, nor Bubie, alone or in combination, teaches or suggests a method of printing an image using a display-free image printing unit, which prints an image corresponding to image data read from an external memory card, and a personal computer, which is connectable to the display-free image printing unit,... wherein a size of image data displayed on a monitor occupies part of a full screen of the monitor and a user prints the image at the image display-free printing unit by selecting a desired image while another application of the user or another user is contemporaneously displayed on the monitor, as is recited in amended independent claim 1.

Thus, it is respectfully submitted that amended independent claim 1 is patentable under 35 U.S.C. §103(a) over Sekikawa (USPN 6,498,658) in view of applicant's admitted prior art in the background of the invention (Background) and further in view of Bubie et al. (USPN 6,453,078), alone or in combination. Since claim 7 depends from amended independent claim 1, claim 7 is patentable under 35 U.S.C. §103(a) over Sekikawa (USPN 6,498,658) in view of applicant's admitted prior art in the background of the invention (Background) and further in view of Bubie et al. (USPN 6,453,078), alone or in combination, for at least the reasons amended independent claim is patentable under 35 U.S.C. §103(a) over Sekikawa (USPN 6,498,658) in view of applicant's admitted prior art in the background of the invention (Background) and further in view of Bubie et al. (USPN 6,453,078), alone or in combination.

C. In the Office Action, at pages 13-15, numbered paragraph III, claim 15 was rejected under 35 U.S.C. §103(a) as being unpatentable over Sekikawa (USPN 6,498,658; hereafter, Sekikawa) in view of applicant's admitted prior art in the background of the invention (hereafter, Background) and further in view of Official Notice. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Independent claim 13 has been amended to include the terminology: "wherein a size of image data displayed on a monitor occupies part of a full screen of the monitor and a user prints the image at the image display-free printing unit by selecting a desired image while another application of the user or another user is contemporaneously displayed on the monitor." This amendment is supported by paragraph [0028] of the specification. The terminology "display-free image printing unit" has been amended to recite ---image display-free printing unit--- for clarity.

MPEP 608.01(n) states: "Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim." Since claim 15 depends from amended independent claim 13, claim 15 incorporates the limitations of amended independent claim 13.

As recited above, neither Sekikawa nor the Background, alone or in combination, teaches or suggests a method of printing an image using a display-free image printing unit, which prints an image corresponding to image data read from an external memory card, and a personal computer, which is connectable to the display-free image printing unit wherein a size of image data displayed on a monitor occupies part of a full screen of the monitor and a user prints the image at the image display-free printing unit by selecting a desired image while another application of the user or another user is contemporaneously displayed on the monitor, as is recited in amended independent claim 13.

On page 13 of the Office Action, the Examiner submits that claim 15 is unpatentable under 35 U.S.C. §103(a) over Sekikawa (USPN 6,498,658) in view of applicant's admitted prior art in the background of the invention (Background) and Official Notice. As noted above, claim 15 incorporates the limitations of amended independent claim 13. By taking Official Notice, the rejection is being based, in part, on the personal knowledge of the Examiner. The personal knowledge of the Examiner, when used as a basis for a rejection, must be supported by an affidavit as to the specifics of the facts of that knowledge when called for by the applicant. See, MPEP 2144.03, 37 C.F.R. § 1.104(d)(2). In short, the rules of the U.S. Patent and Trademark Office require that the Examiner must either support this assertion with an Affidavit, or withdraw the rejection. Therefore, it is further respectfully requested that the Examiner support the rejection with either an affidavit or a reference, or withdraw the rejection with respect to Official Notice.

In view of the above arguments, it is respectfully submitted that amended independent claim 13 is patentable under 35 U.S.C. §103(a) over Sekikawa (USPN 6,498,658) in view of applicant's admitted prior art in the background of the invention (Background) and further in view of Official Notice, alone or in combination. Since claim 15 depends from amended independent claim 13, claim 15 is patentable under 35 U.S.C. §103(a) over Sekikawa (USPN 6,498,658) in view of applicant's admitted prior art in the background of the invention (Background) and further in view of Official Notice, alone or in combination, for at least the reasons amended independent claim 13 is patentable under 35 U.S.C. §103(a) over Sekikawa (USPN 6,498,658) in view of applicant's admitted prior art in the background of the invention (Background) and further in view of Official Notice, alone or in combination.

## **CONCLUSION:**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for

allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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